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Xio Interactive Inc.*

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

TETRIS HOLDING, LLC and THE
TETRIS COMPANY, LLC,

Plaintiffs,

-against-

XIO INTERACTIVE INC.,

Defendant.

Civil Action No. 3:09-CV-6115 (FLW) (DEA)

Honorable Freda L. Wolfson, U.S.D.J.
Honorable Douglas E. Alpert, U.S.M.J.

**XIO INTERACTIVE INC.'S STATEMENT OF UNDISPUTED
MATERIAL FACTS IN SUPPORT OF ITS MOTION FOR
SUMMARY JUDGMENT OF NON-INFRINGEMENT**

Pursuant to L.R. 56.1, Defendant Xio Interactive Inc. submits this separate statement of undisputed material facts in support of its motion for summary judgment. This statement, when read with Xio's Memorandum in Support of Motion for Summary Judgment, establishes that Defendant is entitled to judgment as a matter of law on all Plaintiffs' claims.

I. BACKGROUND FACTS

1. Plaintiffs claim that Xio's game *Mino* infringes their rights to the electronic puzzle game *Tetris*, invented in 1984 by Alexey Pajitnov. *See* Declaration of Sonali D. Maitra in Support of Xio Interactive Inc.'s Motion for Summary Judgment submitted herewith ("Maitra Dec.") at Exs. 2 & 3.

2. A YouTube demonstration of *Tetris* can be found here:
<http://www.youtube.com/watch?v=6Wz4dlYF91o>. And a YouTube demonstration of *Mino* can be found here:
<http://www.youtube.com/watch?v=5X11MMZ6GUU>.

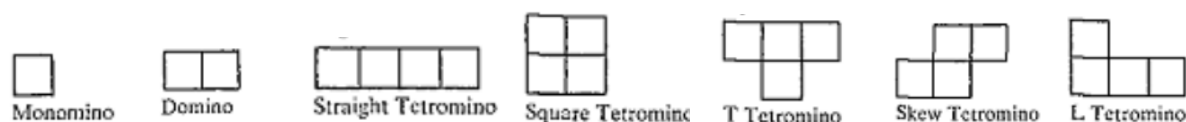
3. One of the predominant features of *Tetris* is the use of tetrominos as the puzzle pieces for the game. *See, e.g.,*
<http://www.youtube.com/watch?v=eguBGUGc8Mo> (YouTube demonstration of *Tetris*).

4. A tetromino is a geometric shape composed of four squares connected at the sides, just like a domino is a similar shape with two squares and a pentomino

is one with five. See Martin Gardner, *Hexaflexagons and Other Mathematical Diversions* 124-150 (1959); J.A.H. Hunter & Joseph S. Madachy, *Mathematical Diversion* 79-86 (1963); Solomon W. Golomb, *Polyominoes* 19 (1968).

5. Mr. Pajitnov did not invent the tetrominos of *Tetris*. For example, as early as 1968, American mathematician Solomon Golomb depicted the tetrominos as follows, including the explanation that they could be “*rotated* (turned 90, 180, or 270 degrees) or *reflected* (flipped over),” as they are in *Tetris*:

Figure 1. The simpler polyomino shapes.

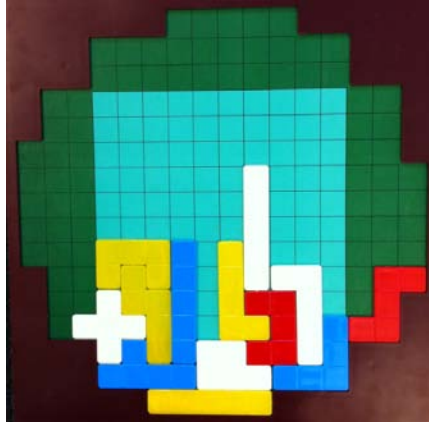


Id. (emphasis in original).

6. Nor did Mr. Pajitnov invent the use of such shapes in a puzzle game, as evidenced by the ancient game pentaminos—a puzzle game in which a player tries to fit pentominos together in a box. [REDACTED]

[REDACTED] In addition, more than a decade before the invention of *Tetris*, Parker Brother’s published a puzzle game called *Universe*. See *id.* ¶ 7. In this game, players rotate brightly-colored pentominos (of which the squares are individually

delineated) and fit them on a grid that ranges from ten by ten to a larger space, depending on the number of players:



Maitra Dec. ¶ 7 & Ex. 6.

II. PLAINTIFFS' CLAIMS

7. Plaintiffs claim copyright over, and infringement of, the following features of *Tetris*:

- (1) The long vertical rectangle playing field or matrix, which is higher than wide.
- (2) The seven tetrominos as playing pieces.
- (3) The seven tetrominos being brightly colored.
- (4) The squares of the tetrominos being individually delineated.
- (5) The appearance of the tetrominos at the top of the matrix.
- (6) The starting orientation of the tetrominos.
- (7) The downward, lateral, and rotating movements of the tetrominos.
- (8) The disappearance of any completed horizontal line.
- (9) The subsequent consolidation of the tetrominos remaining on

the playing field as a result of the downward shift into the space vacated by the disappearing line.

- (10) The display of “garbage lines” with at least one missing square in random order.
- (11) The appearance of a “ghost” or shadow tetromino under the tetromino.
- (12) The display of the next tetromino that will fall down the matrix above the playing field.
- (13) The change in color of the tetrominos when they are in lock-down mode.
- (14) The screen layout in multiplayer versions with the player’s matrix appearing most prominently on the screen and the opponent’s matrices appearing smaller than the player’s matrix and to the side of the player’s matrix.
- (15) The appearance of squares automatically filling in the matrix from the bottom to the top when the game is over.

See id. Exs. 2 & 7.

8. Xio admits that *Mino* contains these features, but contends that none of these features are protected by copyright.

III. XIO’S EFFORTS TO AVOID INFRINGEMENT

9. In the fall of 2008, Xio CEO Desiree Golden decided she wanted to develop a game application for Apple Inc.’s iPhone. *See* Maitra Dec. Ex. 8. The developers at Xio liked *Tetris* games and, while *Mino* was still in its nascence, analyzed intellectual property laws to ensure that the game they would write would not infringe anyone’s rights. *Id.* Exs. 8-22.

10. Specifically, Xio researched the history of *Tetris*, the interaction and

applicability of copyright, trademark, and patent law, “look and feel” case law, the processes and structure around copyright enforcement (as well as protecting against spurious enforcement), copyright registrations for *Tetris* and its variants, specific rules of *Tetris* as determined by industry experts and academics, and articles on copyright for user interfaces. *Id.* Exs. 10-15. In addition, and also in the fall of 2008, Xio reviewed the following Copyright Office circular:

Copyright does not protect the idea for a game, its name or title, or the method or methods for playing it. Nor does copyright protect any idea, system, method, device, or trademark material involved in developing, merchandising, or playing a game. Once a game has been made public, nothing in the copyright law prevents others from developing another game based on similar principles. Copyright protects only the particular manner of an author’s expression in literary, artistic, or musical form.

Id. Ex. 9. This all occurred in the fall of 2008, at the very beginning of development of *Mino*. *See id.* Exs. 11, 15-17, 19-21.

11. Xio discovered that Plaintiffs did not own a patent to the rules, game mechanics, or functional elements of *Tetris*—that Plaintiffs only had copyright, trademark, and trade dress rights to the game. *See id.* Ex. 8-18, 22.

12. For example, in December of 2008, Xio wrote:

The game concept of Tetris was once patentable. However, because it was never patented, it now lies in the public domain. Moreover, had Pajitnov patented Tetris at the time of its invention (1985), by now (23 years later), his patent rights have expired.

What this means is that no legal framework currently protects the replication, improvement, or sale of Tetris game mechanics and rules.

Id. Ex. 16.

13. Also in December 2008, Xio wrote:

Copyright: prohibits others from copying the creative expression of an idea. This covers “original works of authorship including literary, dramatic, musical, artistic and other intellectual works.” (USPTO). The Tetris Company owns a copyright on the audiovisual effects of certain Tetris Games (Family Tetris, Magical Tetris, etc.). This means first: I can not break in, steal the TC’s code, and use it for my game. Second: it also means that I can not reproduce an audiovisual effect that does not stem directly from Tetris game mechanics.

Id. Ex. 17.

14. Xio concluded that it had “come to believe that the Tetris Company has been using its Copyright claims unjustly in order to profit from a monopoly on an un-patented game by bullying independent developers into removing their versions from the internet and now from the iPhone AppStore.” *Id.* Ex. 19.

15. In an effort to confirm this understanding, Xio contacted a number of attorneys. *See id.* at Exs. 18-20. And, still in the fall of 2009, one of these attorneys confirmed Xio’s analysis, stating that this early legal analysis was “spot on.” *Id.* Ex. 21.

16. Xio’s legal analysis was codified in an internal memorandum entitled “Tetris Company Legal Notes.” *Id.* Ex. 22. The memo explained “[w]hile the rules of games are patentable . . . The Tetris Company holds no patents whatsoever, and even if they did, those patents would have long since expired.”

Id. It concludes that copyright protection would not prevent Xio from producing *Mino*, as it contained the rules, and only the rules, of *Tetris*—and specifically cites the Copyright Office circular as legal support for this conclusion. *Id.* The memorandum analyzes the common features of *Mino* and *Tetris* to determine that each is a rule or an otherwise functional aspect of the game. *Id.* It further explains how the expressive elements of *Mino*—including the graphics and music—were independently created (and different from) *Tetris*. *Id.*

17. And in fact, Xio wrote the computer code from scratch. *See id.* at Exs. 22 & 23. In addition, Xio independently created the music for the game (and scrapped a “*Tetris*-like” song for fear of infringement). *See id.* at Exs. 25-32. It independently developed the colors for the game using a unique algorithm it invented. *See id.* at Exs. 33 & 34. And it independently created all graphical files used in the game. *See id.* at Exs. 32 & 22.

IV. THE RULES OF *TETRIS*

18. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

19. Xio's videogame expert, Jason Begy, provides the following definition for rules: the limitations and affordances of the game. Maitra Dec. Ex. 36 at ¶ 16. This definition is explained by the world-renowned game designer and scholar Jesper Juul:

Rules specify *limitations* and *affordances*. They prohibit players from performing actions and this affords players meaningful actions that were not otherwise available; rules give games structure. The board game needs rules that let the players move their pieces as well as preventing them from making illegal moves the video game needs rules that let the characters move as well as rules that prevent the character from reaching the goal immediately.

Jesper Juul, *Half-Real* 58 (2005) (emphasis in original).

20. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

21. Xio's expert explains this distinction in the context of videogames:

Take the original Super Mario Bros. and Sonic The Hedgehog games. The two have nearly identical rules. In both games the player must reach a target point far away to the right of their starting point. In both games this is done by running through the environment, jumping over obstacles, and jumping onto enemies. In both games if the character

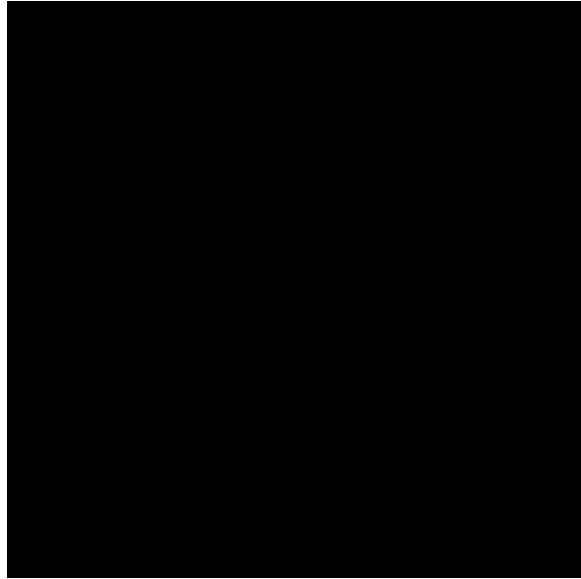
runs into (as opposed to jumping on top of) an enemy, the character “dies” and the player must restart. Both games feature “power ups” that enhance the character’s abilities. Both games feature collectible objects (coins and rings, respectively) that award the player an extra life upon collecting 100.

The rules of these two games are very similar, but the expression given to those rules is vastly different. Nobody would confuse Nintendo’s iconic Mario with Sega’s iconic Sonic. The stories these games tell are also different: Mario is an Italian plumber, originally from Brooklyn, who travels to the Mushroom Kingdom where he repeatedly saves the Princess. Sonic’s world has no tie to the real world, and his mission is to save small animals from being transformed into killer robots and to find the “chaos emeralds” before his nemesis does.

Maitra Dec. Ex. 36 at ¶¶ 87-88.

22. By contrast, Plaintiffs define the rules of a game as ‘[REDACTED]’ ” *Id.* Ex. 38 at 24:17-25. Plaintiffs further define the rules of *Tetris* as limited to the following: “an object appears on a playing field and the player manipulates the object to a final resting spot, to create a shape which is then removed from the playing field.” *Id.* Ex. 46 at 7.

23. Yet Plaintiffs have provided source code for a *Tetris* demo (TETRIS-XIO-0080146) that Plaintiffs’ internal documentation describes as follows: ‘[REDACTED]’ ” *Id.* Ex. 39 (emphasis added). Here is a screenshot of the demo:

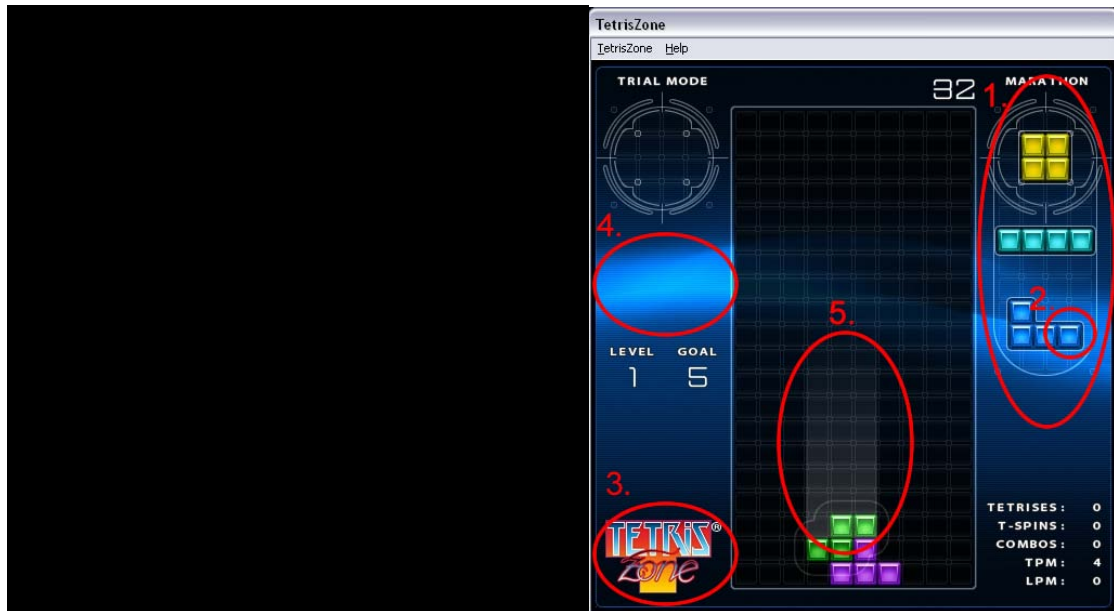


Id. Ex. 36 at ¶ 23.

24. [REDACTED]



25. The following is a screenshot comparison of the demo with the licensed game *Tetris Zone* (with numbered circles added):



See id. Ex. 36 at ¶ 23& Ex. 1.

26. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

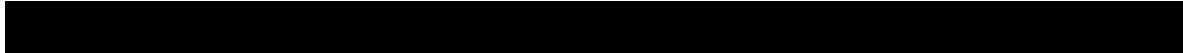
27. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]



28. Plaintiffs have two copyrighted board games based on *Tetris*: Milton Bradley's *Tetris* and the just-released *Tetris Link*, described on Plaintiffs' website at <http://www.tetris.com/products/tetris-link.aspx>. *See id.* ¶¶ 2, 49 and Ex. 48.

Tetris Link looks like this:



Id. at ¶ 50 & Ex. 48. The board game *Tetris Link* has a number of identical features to the video game *Tetris*: on a 10 by 20 grid, players manipulate seven brightly-colored tetrominos, whose blocks are individually delineated, and which rotate and move laterally and downwards. *Id.* at ¶ 2. On the box for the game, there is the following statement: “Tetris ® & © 1985-2011 Tetris Holding. Tetris

logos and Tetriminos are trademarks of Tetris Holding. Trade dress owned by Tetris Holding. Licensed to the Tetris Company. Tetris Game Design by Alexey Pajitnov.”

(1) The long vertical rectangle playing field or matrix, which is higher than wide.

29. If the standard rectangular playing field of twenty cells high by ten cells side were changed to an eight by eight grid, clearing lines might be simpler given that that fewer pieces would be needed to complete a horizontal line. At the same time, gameplay might be more difficult in that the total space in the matrix, and, relatedly, the time to place a piece on the board, would decrease.

30.

31.

32.

(2) The seven tetrominos as playing pieces.

33. The number of squares in a playing piece directly affects the resources available to the player. For example, reducing the number of squares in a playing piece from four to three or two—i.e., to trominos or dominos—results in fewer playing pieces in total, thereby reducing the player’s options and simplifying her decisions.

34. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

35. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

36. [REDACTED]

[REDACTED]

[REDACTED]

37. Mr. Pajitnov did not choose particular tetrominos, he used all the four-square shapes that exist. *See Golomb, supra* at 19.

(3) The tetrominos being brightly colored.

38. Brightly coloring the tetrominos ensures that the pieces are recognizable against the background. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(4) The squares of the tetrominos being individually delineated.

39. Delineating the individual squares of the tetromino enables a player to see where the tetromino that is in play fits on the grid and its relationship to the other tetrominos already on the board. Without this feature, the game would be more difficult to play.

(5) The appearance of the tetrominos at the top of the board.

40. If tetrominos appeared not at the top, but halfway down, the game would be more difficult as players would have less time within which to place the tetrominos. Or if tetrominos appeared at one of the sides of the board, it would be more difficult to get a space to the other side of the board.

41. [REDACTED]

[REDACTED]

[REDACTED]

(6) The starting orientation of the tetrominos.

42. The starting orientation of the tetrominos is a rule—directly affecting the functioning of the game. The number of times a player has to rotate a piece to place it in a desired spot is directly related to the starting orientation of the piece.

43. The starting orientation of the tetrominos is not the same across the *Tetris* games that Plaintiffs accuse Xio of infringing. *See id.* at ¶ 3. As just one example, compare *Tetris Pop*, demonstration available at <http://www.youtube.com/watch?v=LlZqiKstRHs>, with *Tetris DX*, demonstration available at <http://www.youtube.com/watch?v=6sPRJPaHENQ>.

(7) The downward, lateral, and rotating movements of the tetrominos.

44. If the tetrominos didn't move downward, lines wouldn't clear. If they didn't move laterally, it would be impossible to complete a horizontal line.

45. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

46. And the shape of the tetrominos—which Plaintiffs did not create—determines how they look when they are turned.

(8) The disappearance of any completed horizontal line.

47. Players arrange tetrominos to create horizontal lines, which are thereby cleared from the board. Clearing tetrominos from the board prevents stacked tetrominos from reaching the top of the playing field and ending the game. Without this feature, fundamental game functioning would change.

48. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

49. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(9) The subsequent consolidation of the playing pieces remaining on the playing field as a result of the downward shift into the space vacated by the disappearing line.

50. Without a downward shift subsequent to a line clear, there would be no way to reduce the height of the blocks already on the board. As a result, it would be impossible to clear more than 20 lines on a 20 by 10 board, and the

game would be over a player had time to blink.

51. [REDACTED]

[REDACTED]

[REDACTED]

(10) The display of “garbage lines” with at least one missing block in random order.

52. “Garbage lines”—horizontal lines placed on the board that are not completely filled—are often employed in multiplayer mode whereby a player is rewarded for good performance by placing garbage lines on her opponent’s board, which raises the height of pieces on the opponent’s board and brings the opponent closer to defeat.

53. [REDACTED]

[REDACTED]

54. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(11) The appearance of a “ghost” or shadow piece under the playing piece.

55. The “ghost piece” is a shadow of the tetromino currently in play that shows where that tetromino will fall on the board. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

56. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] It would be harder to play a game that lacked this feature.

(12) The display of the next tetromino that will fall down the matrix above the playing field

57. The ability to view what piece will come next allows the player to better strategize where to place the current piece in play. [REDACTED]

[REDACTED]

[REDACTED]

58. As with the ghost tetromino, it would be harder to play a game that lacked this feature. [REDACTED]

[REDACTED]

(13) The change in color of the tetrominos when they are in lock-down mode.

59. Lock-down mode occurs when a tetromino is no longer in play, when it settles into its final position on the board. Changing the color of the pieces that are no longer in play communicates two messages: that the locked-down tetromino is no longer active and that a new tetromino is in play. The player is better able to focus on the active tetromino as it descends down the board. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(14) The screen layout in multiplayer versions with the player's board appearing most prominently on the screen and the opponent's boards appearing smaller than the player's board and to the side of the player's board.

60. This is element of highlights a player's board over her opponents' boards. Reversing this—with an opponent's board as the largest—would not make sense. And having all boards equally sized would unnecessarily confuse the player's board with her opponents'.

(15) Combination of all elements.

61. All of the above elements are functional—either because they are a limitation and/or affordance of the game or because they otherwise play a

functional role in the game. Each one element affects the other, and the combination of the elements working together is necessarily functional as well. *Id.*

Ex. 36 at ¶ 79.

Dated: September 30, 2011

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XIO Interactive, Inc.*

CERTIFICATE OF SERVICE

I certify that on September 30, 2011, I caused a copy of defendant's motion to seal certain documents to be served upon plaintiffs' counsel of record via the Court's electronic filing system.

/s/ Donald A. Robinson

Donald A. Robinson